Remarks

Claims 422-463 are presently pending in the subject application. Claims 451 and 452 have been amended herein to properly indicate that these claims depend from method claims. In accordance with the provisions set forth in 37 C.F.R. § 1.121, a marked-up version of these amendments to the claims is attached hereto.

The Examiner has imposed a restriction requirement which divides the claims into two groups. The claims of Group I (claims 422-440) are drawn to oligonucleotide compositions, and the claims of Group II (claims 441-463) are drawn to methods for determining the presence of a nucleic acid analyte in a sample. The Examiner concludes that the inventions of the two groups are distinct from each other on the basis that the oligonucleotides of Group I may be used as nucleic acid expression inhibitors rather than probes, as recited in the methods of Group II. In response, Applicants elect the claims of Group I and traverse this requirement for the reasons that follow.

Applicants first observe that the burden on the Examiner to search both groups of claims would not be significantly greater than the burden on the Examiner to search any one of the restriction groups. For example, to conduct a search of prior art relevant to the claims of Group II, the Examiner would necessarily have to search art which might disclose the compositions of the claims of Group I. If, during such search, the Examiner discovered prior art which disclosed the claimed compositions for uses other than the claimed use, it would be incumbent upon the Examiner to determine whether such prior art would suggest or motivate the claimed use. Thus, maintaining all pending claims in a single application should not add to the Examiner's search burden.

In addition, the Examiner's contention that the oligonucleotides recited in the claims of Group I might be used as nucleic acid expression inhibitors is unsupported. While the Examiner is not required to document an alternative use example, (*see* MPEP § 806.05(h) at 800-46 (8th ed., Aug. 2001)), Applicants submit that the Examiner's suggested alternative use is impracticable for a couple of reasons. First, the claimed oligonucleotides include regions which are self-hybridizing under nucleic acid assay conditions, a feature which would interfere with their use as expression inhibitors (*e.g.*, antisense oligonucleotides) under physiological conditions. Second, the claimed

oligonucleotides are capable of being detected when hybridized to a nucleic acid analyte under nucleic acid conditions. However, the Examiner has not explained how such detection would be achieved with antisense oligonucleotides unless such oligonucleotides were being used as detection probes. Therefore, Applicants submit that the burden has shifted to the Examiner to support the alleged alternative use or to establish another *viable*, alternative use. Absent such a showing, Applicants submit that the Examiner must withdraw the restriction requirement. *See* MPEP § 806.05(h).

No fee is believed due in connection with this Response. If Applicants are mistaken, please charge the amount due to Deposit Account No. 07-0835 in the name of Gen-Probe Incorporated.

Certificate of Transmission

I hereby certify that this correspondence (and any referred to as attached) is being sent by facsimile to 703-872-9306 on the date indicated below to Box Non-Fee Amendment, Commissioner for Patents, Washington, D.C. 20231.

Respectfully submitted,

Date: January 22, 2003 By: _____

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Marked-Up Version of Amendments

IN THE CLAIMS:

The claims have been amended as follows:

451. (Amended) The [oligonucleotide] method of claim 441, wherein the nucleic acid analyte comprises RNA.

452. (Amended) The [oligonucleotide] method of claim 451, wherein the nucleic acid analyte comprises ribosomal RNA.